

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. EBELING II

Appeal No. 98-0430
Application 08/688,141¹

ON BRIEF

¹ Application for patent filed July 29, 1996. According to appellant, the application is a continuation of Application 08/398,000, filed March 3, 1995, abandoned; which is a division of Application 08/059,185, filed May 6, 1993, now U.S. Patent 5,421,493, issued June 6, 1995.

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Before COHEN, ABRAMS and FRANKFORT, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 9 through 12, as amended subsequent to the final rejection. These claims constitute all of the claims remaining in the application.²

Appellant's invention pertains to a baseball or soft- ball pocket forming tool. An understanding of the invention can be derived from a reading of exemplary claim 9, a copy of which appears in APPENDIX A of the reply brief (Paper No. 15).

² Based upon the explicit statement in the answer (page 2) that claims 1 through 8 were canceled, it appears to us that the amendment canceling claims 2 through 4, attached to the main brief (Paper No. 13), was entered by the examiner, although no notation to that effect appears on the referenced amendment.

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As evidence of obviousness, the examiner has applied
the documents listed below:

Schnase et al. (Schnase)	2,121,989	June 28, 1938
Posey	4,454,204	June 12, 1984
Walker (Great Britain)	554	Dec. 23, 1898

The following rejections are before us for review.

Claims 9 through 12 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Walker in view of Schnase.

Claims 9 through 12 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Posey.

The full text of the examiner's rejections and
response to the argument presented by appellant appears in the
answer (Paper No. 14), while the complete statement of appel-

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lant's argument can be found in the main and reply briefs
(Paper Nos. 13 and 15).³

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,⁴ and the respective viewpoints of appellant and

³ On September 17, 1998, Craig R. Feinberg, a Program and Resource Administrator at the Board of Patent Appeals and Interferences, discussed an amendment to claim 9, filed with the reply brief, with the examiner, and determined that the examiner entered this amendment. Thus, we have assessed claim 9 as including this amendment. The clerical entry of the amendment should be made during any further prosecution before the examiner.

⁴ In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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the examiner. As a consequence of our review, we make the determinations which follow.

The rejections based upon Walker and Schnase

We reverse the rejection of claims 9 through 12 under 35 U.S.C. § 103 as being unpatentable over Walker in view of Schnase.

Initially, we note that appellant's independent claim 9 is drawn to a baseball or softball glove pocket forming tool made from a material selected from wood, plastic and metal and comprising, inter alia, an enlarged head portion having an essentially spherical surface with a radius from about 1 to 2 inches,

with the enlarged head portion of the tool being intended to be pounded into a baseball or softball glove.

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As evidence of obviousness, the examiner relies upon the teachings of Walker and Schnase.

The Walker patent addresses a constable's staff consisting of a solid piece of indiarubber 14 inches long. As depicted in the sole drawing figure, an end of the staff has an arcuate appearance.

The patent to Schnase teaches a combined handle grip and weapon. More specifically, the sleeve 12, that acts as a knob on a conventional gear shift lever (Fig. 1), can be removed for use as a club or blackjack (Fig. 2). When used as a club, the shaft portion 12 serves as a handle and the head 14 forms a striking member. The head 14 is formed of a substantially ball-shaped member 16 with a rubber coating 18 thereon.

When we set aside what appellant has disclosed in the present application, we find that the combined teachings

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of Walker and Schnase would not have, in particular, been suggestive

of an article, a tool as claimed, wherein an enlarged spherical head portion, intended to be pounded into a baseball or softball glove, has a radius of from about 1 to 2 inches. Simply stated, the applied references are silent on particular dimensions for any spherical end and, as we see it, provide no motivation to effect a spherical end with a radius from about 1 to 2 inches, as now claimed. Thus, the rejection is reversed.

The rejection based upon Posey

We reverse the rejection of claims 9 through 12 under 35 U.S.C. § 103 as being unpatentable over Posey.

Considering again the content of claim 1, and setting aside appellant's disclosure, it is at once apparent to us that the tool for pounding, now claimed, would not have been suggested by the combined bank for coins and noisemaker

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of Posey, keeping in mind that the claimed tool includes an enlarged spherical head portion with the head portion being of a radius of from about 1 to 2 inches and being intended to be pounded into a baseball or softball glove. We perceive no reasonable basis in the Posey patent that would have motivated one of ordinary skill in the art to configure a ball design, as taught by Posey, with the particular radius range of from about 1 to 2 inches, now claimed. It follows that this rejection must be reversed.

At this juncture, we make note of the declaration of John J. Ebeling II, a copy of which is appended to the main brief. As to the content thereof, we point out that the claims on appeal are not commensurate with declarant's indication (paragraph 9) that to make a suitable pocket the diameter of the tool head "must be at least 2 inches."

REMAND TO THE EXAMINER

We remand this application to the examiner to consider the claimed subject matter relative to arts addressing

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hand tools that work material by pounding. One such art is the pestle art.

The patent to Maris (U.S. Patent No. 278,575, issued May 29, 1883), a copy of which is attached to this opinion, is exemplary.

In summary, this panel of the board has:

reversed the rejection of claims 9 through 12 under 35 U.S.C. § 103 as being unpatentable over Walker in view of Schnase; and

reversed the rejection of claims 9 through 12 under 35 U.S.C. § 103 as being unpatentable over Posey.

Additionally, we have remanded the application to the examiner for consideration of arts addressing hand tools that work material by pounding.

The decision of the examiner is reversed.

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REVERSED AND REMANDED

	IRWIN CHARLES COHEN)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	NEAL E. ABRAMS)	APPEALS AND
	Administrative Patent Judge)	INTERFER-
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)	
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	Administrative Patent Judge)	

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